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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,854	06/07/2005	Jeffrey J. Fisher	25,961-20US	7199
7590 05/11/2007 Fulbright & Jaworski 2100 Ids Center 80 South Eighth Street Minneapolis, MN 55402-2112			EXAMINER MATTER, KRISTEN CLARETTE	
			ART UNIT 3771	PAPER NUMBER
			MAIL DATE 05/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

10/537,854

Applicant(s)

FISHER ET AL.

Examiner

Kristen C. Matter

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3771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 7-17 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 5, 7, 11, 12, 13, 14, 15, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shayan (US 6,772,756) in view of Frank (US 4,903,850).

Regarding claims, 1, 11, 12, and 13 Shayan discloses a vaporizing device with a reservoir (40, 22) and a removable vapor-concentrating lid (12) for the inhalation of a volatile substance (column 2, lines 50-55). Examiner contends that volatile is synonymous with effervescent.

Shayan does not disclose that the vapor-concentrating lid comprises a central depressed area for loosely engaging a user's nasal area. However, Frank discloses a vaporizing device for inhalation of vapors by a user with a lid (14) having a centrally depressed area (see figures 1 and 2).

Depending on how hard the user presses his or her face into the area, the nasal area would be loosely engaged. In addition, as seen in Figure 1, the nasal area (i.e., the nostrils) is loosely engaged even if the bridge of the nose is sealed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided Shayan's device with a removable hood as taught by Frank for allowing the user to better direct the vapor into the nose for inhalation.

Regarding claim 2, the reservoir disclosed by Shayan can be considered a cup (see Figure 3).

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Regarding claim 3, Shayan discloses that the device can be made of a plastic (column 4, lines 59-60) and that the receptacle and top can be made integrally (column 6, lines 50-55).

However, to the extent that to the extent that Shayan is silent as to the material of the reservoir specifically, it is considered an obvious design choice to use a material suitable for a given use. See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960), in which the selection of a known material based on its suitability for its intended use supported a prima facie case of obviousness.

Regarding claim 5, Shayan discloses air vents (16) in the casing. In addition, Frank discloses vents in the lid (147).

Regarding claim 7, Shayan discloses that the receptacle and lid are interchangeable (column 6, lines 50-55) and the opening on the underneath side of the lid can be closed with the rest of the casing (i.e., closable opening) after adding water and an effervescent composition to the receptacle.

Regarding claims 14-17, the modified device disclosed by Shayan and Frank has all of the structural limitations needed to perform the recited method steps and is fully capable of doing so. It would have been obvious to one of ordinary skill in the art at the time the invention was made, upon seeing the modified device, to perform the recited method steps of the instant claim. Depending on the type of pharmaceutical substance added to the reservoir, any number of different conditions could be treated.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shayan and Frank as applied to claim 1 above, and further in view of Ninkov (US 2003/0225003). Shayan is silent

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as to the specifics of the volatile substance, although Shayan does disclose that the volatile substance can be emulsions or liquids (column 6, lines 40-45). Ninkov discloses useful therapeutic compositions for oral inhalation to treat infection that include liquids and emulsions of polyethylene glycol (paragraphs 0095 and 0137). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a polyethylene glycol emulsion in the modified device disclosed by Shayan and Frank in order to treat a given infection.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shayan and Frank as applied to claim 1 above, and further in view of Silten (US 2,033,489). Shayan is silent as to the specifics of the volatile substance. Silten discloses a device for the inhalation of vapors comprising substances with excipients (column 6, lines 55-60) and dyes (column 1, lines 40-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used substances including excipients and dyes as taught by Silten in the modified device of Shayan and Frank in order treat various eye and skin conditions.

Allowable Subject Matter

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-3, 7-9, and 10-17 and the Hill reference have been considered but are moot in view of the new ground(s) of rejection.

Regarding Applicant's argument that the lid disclosed by Shayan is not removable, Examiner points Applicant to Figure 3, which clearly shows the lid (12) can be removed from the body of the device (appears to be an interference fit).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Shayan and Frank disclose devices for producing vapors that can be inhaled. Although Applicant contends that Shayan is directed solely to a "waterless apparatus", Examiner points to column 6, lines 40-45 of Shayan, which teach that liquids can be used in the device either on a sponge or by itself to be vaporized.

Regarding Applicant's argument that Frank does not disclose a lid with a central depressed area that loosely engages a user's nasal area, Examiner points to Figures 1 and 2 of Frank which show a lid that clearly has a central area that is cut out (i.e., depressed) and that can be loosely engaged by the user's nasal area either by defining the nasal area as the nostrils (which are not sealed by the lid) or by not pressing face firmly into the lid.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

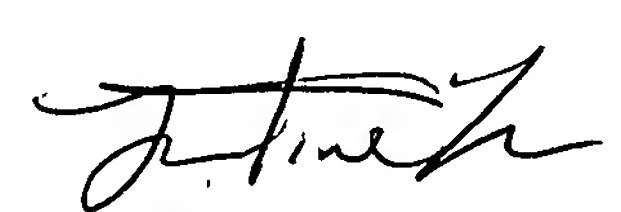
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristen C. Matter whose telephone number is (571) 272-5270. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kristen C. Matter
Examiner
Art Unit 3771


JUSTINE R. YU
SUPERVISORY PATENT EXAMINER
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5/9/07